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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,117	09/29/2001	Robert D. Dickinson III	TUMB-102 CON2	9177

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PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
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NEW YORK, NY 10036

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/967,117	Applicant(s) DICKINSON ET AL.	
	Examiner Paul Callahan	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15 and 29-31 is/are rejected.
- 7) ☐ Claim(s) 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 7-24 and 29-33 were pending in this application at the time of the previous Office Action. Claims 7-12 and 16-24 have been cancelled by the latest amendment. Therefore claims 13-15 and 29-33 remain pending and have been examined.

Information Disclosure Statement

2. The information disclosure statement filed 12-28-2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The Non-Patent Literature reference cited in the Applicant's IDS is not found in the Image File or elsewhere. Therefore the applicant will have to resubmit the reference.

Response to Arguments

3. Applicant's arguments with respect to claims 13-15 and 29-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-15 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landfield US 5,632,011, Stockwell, US 6,072,942, Ji et al., US 5,889,943, and Apperson et al., US 5,978,484.

As for claims 13 and 14: Landfield teaches a method for controlling e-mail message transmission across an email firewall (abstract), the e-mail firewall interposed between an internal network associated with a first policy and an external network (abstract, fig. 1), the method comprising: intercepting a plurality of data packets associated with a message from a sender user associated with the internal network (abstract), the message directed to a recipient user associated with an external network (abstract), and assembling said data packets to an application level message (col. 4 lines 25-45). Stockwell teaches the features of claim 13 that Landfield fails to teach, namely: filtering the application level message by examining textual content associated with the application level message by employing content filter conditions of the first policy to provide a filtering result (col. 10 lines 1-34), and restricting the transmission of the application level message in accordance with said filtering result (col. 10 lines 1-34). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Stockwell into the system of Landfield. It would have been desirable to do so since textual filtering would provide greater e-mail

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security. The combination of Landfield and Stockwell does not teach requiring attachments that are executable files to have a digital signature, however Ji et al. teaches a e-mail firewall that scans executable attachments to e-mail messages (col. 3 line 44 through col. 4 line 36, col. 14 lines 25-45), and Apperson et al. teaches a system wherein a user who receives an executable file sent over a network first verifies that the executable has a valid signature before execution by reference to a directory of trusted signatures (abstract, fig. 1 element 36, fig. 5 element 114, col. 2 line 47 through col. 3 line 10, col. 8 lines 28-44, fig. 3). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features of Ji and Apperson into the system of Stockwell and Landfield. It would have been desirable to do so since this would provide for increased security in delivery of executable files via e-mail. Motive to make this combination is found, for example, at col. 14 lines 53-59 of Ji where the desirability of scanning an executable attachment to prevent the spread of a computer virus is discussed.

As for claim 15, Stockwell teaches a method of Claim 7 that Landfield fails to explicitly teach, namely one wherein said restricting the transmission includes routing the message in accordance with user defined routing policies (col. 10 lines 1-34). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Landfield. It would have been desirable to do so as user defined routing of such restricted messages would provide greater user control over message functions such as quarantine.

As for claims 29-31, the claim limitations are substantially the same as claims 13 and 14. The limitations are taught by the combination of Landfield and Stockwell as per the rejection of claims 13 and 14 found supra. Therefore claims 29-31 are rejected on the same basis as are claims 13 and 14.

Allowable Subject Matter

6. Claims 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field, Landfield, Stockwell, Ji, and Apperson, do not teach the features found in claims 32 and 33, of selection of a second policy condition to be used in filtering an e-mail message by reference to a valid digital signature, and wherein this second policy condition is a reference to whether the digital signature is associated with a trusted domain.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

3-30-06

Paul Callahan


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER